REMARKS

This is in response to the Office Action mailed May 14, 2008, which noted that claims 1-52 were pending for consideration. Claims 1, 25, 31 and 49-52 have been amended herein. New claims 53-56 have been added. Thus, claims 1-56 are pending for consideration, which is respectfully requested. No new matter has been added.

Applicants have submitted herewith a CD having stored thereon "StraussController.exe" as Exhibit A and "StraussDrag.mov" as Exhibit B. Exhibit A is an executable applet simulating an example of "a mobile tracking region having a region boundary coincident with the menu boundary and enclosing the tracking symbol" as recited in claim 1. Exhibit B is a movie comparing the functionality of Strauss with an example of the menu functionality according to claim 1.

Rejection under 35 U.S.C. § 101

On page 2, item 7, the Office Action rejected claims 1-27, 31 and 49-52 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Claims 1, 25, 31 and 49-52 have been amended herein. For example, claim 1 has been amended to recite "A graphical user interface **display,** comprising... a menu, on the display..." Applicants submit that claims 1, 25, 31 and 49-52 are even now more fully directed to statutory subject matter. Accordingly, Applicants request the rejection for claims 1-27, 31 and 49-52 be withdrawn.

Rejection under 35 U.S.C. § 103(a)

On page 3, item 9, the Office Action rejected claims 1-4, 6-9, 10-11, 13-15, 20-24, 25-28, 32-34, 37-38 and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Iwema (Patent No. U.S. 7,058,902) in view of Strauss (Patent No. U.S. 6,246,411). This rejection is respectfully traversed.

On page 5, second paragraph, the Office Action concedes that Strauss fails to teach that the region boundary is coincident with the menu boundary. The Office Action, however, states:

> it would have been obvious to one of ordinary skill in the art at the time the
> invention was made to have implemented this limitation because Strauss
> suggests to the skilled artisan that different designs can be applied for the drag
> toolbar such as the drag toolbar can be in different shapes with different controls
> (e.g., see Figs. 2A-4B; col. 4, lines 24-54). One would be motivated to implement
> this feature is to provide a user with a visual cue or feature as to what the tracking
> boundary is so that the user may use the tracking menu more efficiently (sic).

As shown above, the Office Action merely provides a conclusion without a rationale, and thus, Applicants respectfully traverse the Office Action's assertion for the reasons discussed below.

First, Applicants submit that the Examiner fails to establish that providing a visual cue for a tracking boundary is obvious. The Examiner merely states that Strauss describes "different designs can be applied for the drag toolbar such as the drag toolbar can be in different shapes with different controls." Merely describing a toolbar with different shapes or controls, however, does not teach or suggest implementing a visual cue (e.g. drawn border) defining a tracking boundary. The Office Action states that one would be motivated to employ such a feature in order to use the tracking menu more efficiently. Applicants respectfully submit, however, that the Office Action's mere assertion of using a menu more efficiently without any teaching or suggestion from the prior art for the feature is based on impermissible hindsight. Applicants submit that a mere motivation to use a tracking menu more efficiently with nothing more does not render such a feature obvious. Alternatively, if the Office Action asserts that such a feature is common knowledge, the Office Action fails to support such an assertion. Applicants submit that these features are not of notorious character or capable of instant and unquestionable demonstration as being well-known (see MPEP § 2144.03(A)). No evidence is provided to support the Office Action's assertion, and thus, it appears that the rejection, at least in part, is based on personal knowledge. Thus, Applicants call upon the Examiner to support such an assertion with an affidavit, provide evidence, or withdraw the assertion.

Second, even assuming *arguendo*, that there is some teaching in Strauss of a visual cue for a tracking boundary, Applicants submit that such a region boundary would not be **coincident** with the menu boundary (e.g. "a mobile tracking region having a region boundary coincident with the menu boundary" as recited in claim 1, lines 4-5). As shown in Strauss Figure 7, the tracking boundary is outside of the menu boundary. Thus, Applicants submit that even assuming *arguendo* the Strauss teaches a visual cue for a tracking boundary, the boundary would cover an area beyond the menu boundary (e.g. see "follow me" zone 42 of Figure 7, see also column 6, lines 59-67).

Third, Applicants submit that Strauss not only fails to teach or suggest "a region boundary coincident with the menu boundary," but teaches away from such a feature. For example, Strauss states "the Drag Toolbar may be floating and have a 'follow me' characteristic, where the Drag Toolbar moves so as to always be **within a certain distance from the cursor**" (Abstract, lines 17-19). In other words, Strauss explicitly states that the Drag Toolbar is within a certain distance *from the cursor* and not that the cursor is *within* the Drag Toolbar – if the region

boundary was coincident to the Drag Toolbar boundary (i.e. cursor confined to space within Drag Toolbar), no reference to distance would be necessary. Further, Strauss states that "the invention provides an unambiguous way for a user to change the drag functionality of a cursor during a drag operation" (Abstract, lines 19-21). In other words, in order to provide an unambiguous way for a user to change the drag functionality (i.e. when a drag action is already activated) a person of ordinary skill in the art would likely not have a boundary region coincident with the menu boundary as errors for changing the drag function are more likely to occur (e.g. as shown in Exhibit B, moving a cursor confined to the Drag Toolbar would constantly highlight/activate items in the toolbar when the cursor is moved, whereas if the boundary is beyond the Drag Toolbar, an item can be activated and then a cursor is moved beyond the toolbar to navigate). Thus, the constant highlighting/activating would likely produce errors in changing a drag function, and would thus, be "ambiguous" which is in contrast to the explicit disclosure of Strauss. Moreover, in contrast to claim 1, for example, Strauss deals exclusively with a drag function. Thus, a person of ordinary skill in the art would want to limit the constant highlighting/activating of menu items because a drag function usually involves a time constraint (i.e. limit the amount of time that a user must hold down the mouse button ("drag")).

In view of the reasons set forth above, Applicants submit that the feature of "a menu having a menu boundary and comprising a mobile tracking region having a region boundary coincident with the menu boundary" as recited by claim 1 is not obvious. Therefore, claim 1 patentably distinguishes over the cited art.

On page 16, item 10, the Office Action rejected claims 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Iwema in view of Strauss further in view of Beaton (Patent No. U.S. 6037937). On page 17, item 11, the Office Action rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Iwema in view of Strauss further in view of Schirmer (Patent No. U.S. 6369837) and further in view of Beaton. On page 18, item 12, the Office Action rejected claims 16 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Iwema in view of Strauss further in view of Hoeber (Patent No. U.S. 5,276,795). On page 19, item 13, the Office Action rejected claims 12-19, 29-30, 39 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Iwema in view of Strauss further in view of Nicholas (Patent No. U.S. 6,865,719). On page 21, item 14, the Office Action rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Iwema in view of Strauss further in view of Schirmer and further in view of Beaton and further in view of Nicholas. On page 25, item 15, the Office Action rejected claims 17-18 and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Iwema in view of Strauss further in view of Hoeber and further in view of Nicholas.

Applicants submit that <u>Beaton</u>, <u>Schirmer</u>, <u>Hoeber</u> and <u>Nicholas</u> fail to cure the deficiencies of <u>Strauss</u> and <u>Iwema</u> described above. Accordingly, the above discussion can be looked to by the Examiner during a review of independent claims 25, 28, 31, 32 and 44-52.

The dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art.

In view of the above, Applicants submit that the rejections be withdrawn.

New Claims

Applicants submit that new claims 53-56 patentably distinguish over the cited art. Independent claims 53 and 54 recite "a menu... having a menu boundary and comprising a mobile tracking region having a region boundary coincident with the menu boundary," and therefore, patentably distinguish over the cited art for at least the reasons discussed above. In addition, claim 54 recites "the menu tracks the tracking symbol when the menu is not visible," which the cited art does not disclose. For example, the menu in <u>Strauss</u> only tracks the tracking symbol when the drag function is initiated (i.e. when the menu is activated/viewable, see column 8, 15-18 and column 6, lines 52-55).

Dependent claims 55 and 56 inherit the patentable recitations of their base claim, and therefore, patentably distinguish over the cited. In addition, claim 55 recites "wherein the region moves in correspondence to the tracking symbol **without activating a selection button on the input transducer**," which the cited art does not disclose (emphasis added). For example, the toolbar in Strauss only appears when a drag function is initiated (column 8, lines 15-18). In order to initiate a drag function, however, a button on the mouse be pressed and held down. Thus, Strauss does not disclose nor contemplate a menu region moving "in correspondence to the tracking symbol without activating a selection button on the input transducer" as recited by claim 55. Further, claim 56 recites "the menu boundary deforms when encountering a persistent object while moving on the display" (see e.g. Specification Figure 13c). Applicants submit that nothing has been found in the cited art that discloses deformation of a menu when it encounters a persistent object. Accordingly, claims 55 and 56 patentably distinguish over the cited art for the additional reasons set forth above.

In view of the above, Applicants submit that claims 53-56 patentably distinguish over the cited art.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____9/1/18_____   By: _____

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